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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,637	06/21/2000	Valerie de la Poterie	05725.0598-00000	6915

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,637

Applicant(s)

DE LA POTERIE ET AL.

Examiner

Lakshmi S Channavajjala

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1615

DETAILED ACTION

Receipt of request for reconsideration, dated 11-7-02 is acknowledged.

The following rejection of paper #9 has been maintained:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 749747

A1. Examiner notes that English equivalent of the EP 749747 is US 5851517, since both EP and US patents claim priority over the same French Application. Therefore the teachings of US reference are relied upon.

EP teaches a composition containing a dispersion of surface stabilized polymer particles in a non-aqueous medium. EP suggests using polymers such as those used for nail polish or mascara (col. 1, lines 10-20 and col. 8 of US patent). EP teaches the same polymers i.e., acrylic or vinyl radical copolymers etc., such as those claimed in the instant (col. 2) and the non-aqueous liquid components such as natural, synthetic, carbon-based or hydrocarbon based oils (col. 3). EP

Art Unit: 1615

further teaches the stabilizers such as sequential or grafted block copolymers, with 2-30% by weight of the stabilizer (col. 5 through 6). EP fails to teach the viscosity of the composition, as claimed in the instant. However, EP teaches various formulations such as gels (example 13), milky dispersion (example 8), and oils etc., which are different in their viscosities. Further, examiner also notes that instant specification states that the polymer preparation of the instant invention is carried out in the same manner as described in EP (pages 13, lines 18-21) and the examples that are within the scope of instant invention also utilize the same polymer dispersion as described in example 7 of EP (see the description of examples on page 25, lines 1-25). Accordingly, absent showing evidence on the contrary, because EP teaches the same polymers, solvents, stabilizers and other cosmetic ingredients in their composition, the cosmetic compositions of EP exhibit the same viscosity as that claimed. EP suggests preparing the composition as a transparent, translucent or opaque dispersion, and use for primarily as hair sprays or for eye lashes treatment 9col. 2, lines 25-29, col. 6, lines 44-59). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare the claimed dispersions of surface stabilized polymer particles in a liquid fatty phase with the desired consistency of the composition, with an expectation to achieve a stable composition that can be effectively used for treating hair or eyelashes.

The following double patenting rejection made in the previous action (paper#7) is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 1615

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims also recite a cosmetic composition, which is similar in scope of the instant claims. Both the patented claims and instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. While the instant claims recite, "for coating keratin fibers", patented claims are also identical in scope because the latter mention the use of eye make up and lengthening the eyelashes. Patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims. However, the patent uses the same polymers for dispersion, stabilization and mentions the viscosity of 3-30 Pa.S (see patented claim 42). Accordingly, the instant claims would have been obvious over the patented claims.

Art Unit: 1615

Response to Arguments

Applicant's arguments filed 6-4-02 have been fully considered but they are not persuasive.

Double Patenting Rejection

Applicants maintain the argument that that the double patenting rejection is not proper because the instant examples 2 and 3 illustrate unexpected results. Applicants argue that while 1.13% polymer (example 2) produced a film that does not withstand rubbing, as compared to the film obtained with 2.23% polymer (example 3). Accordingly, applicants argue that optimizing is not obvious, because the properties may be sensitive to small variations in percentages. Applicants also argue that the patented claims fail to recite the limitations regarding the weight percentages of the polymer and viscosities.

This argument is not persuasive because claim 23 of Mougin clearly recites viscosities the range from 3-30 Pa.S at 25degrees C. Instant claims recite viscosities 2 to 17 Pa.S which is clearly with the range of patented claims. Besides, the composition of the patented claims is also used for the same purpose (claim 30 of the patent) i.e., coating keratin fibers. Further, the patented claims also recite the product in the form of a mascara, eye shadow, foundation or lipstick etc., and in particular, claim 30 recites a method of improving the lengthening of the eyelashes. Accordingly, merely altering the percentages of the same polymer to show that the viscosities and thus the keratin coating properties are altered is not unexpected by one of an ordinary skill in the art.

Art Unit: 1615

103 Rejection- EP 749747 (relied on US 5,851,517):

Applicants argue that instant claims are the viscosity of the composition cannot be same merely because some of the components are same. Further, applicants also urge that office admits that the reference teaches various formulations (gels, milky dispersions etc.), which are different in viscosities, which do not exhibit the same viscosities as claimed. This argument is not persuasive because, the examples of '517 in cols. 9-11 use different polymer dispersions, wherein the methacrylate polymer (preparation of dispersion in examples 1-9 (cols. 6-9) used is in the range of 15. Thus, the different compositions, such as gels, creams etc., of '517 contain more 2% of the polymer. Thus the amount of polymer meets the claim limitation of at least 2%. With respect to the viscosities, the examples 1-9 of '517 result in dispersions having different solid contents and the final compositions (examples 10-13) employ dispersions having different percentages of solids. Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amount of a polymer in the in the composition of '517 because the polymer particles of '517 are also used for the same purpose as that of the instant i.e., film-forming. Further, '517 also teach stabilizing the polymer particles, without forming aggregates, in the same way in the instant invention. Applicants argue that the aim of their invention is to propose a dispersion of particles, which remain in the form of elementary particles, without forming aggregates, when they are in dispersion in non-aqueous media. '517 precisely teach the same using the stabilized polymers in their invention (abstract, col. 2, lines 25-32). Examiner notes that applicants did not argue regarding the polymers and stabilizers taught by '517. Thus, when the components of the composition are taught by the prior art for the same purpose as that of the claimed invention, choosing the amounts, percentages and conditions

Art Unit: 1615

for preparing the composition with an expectation to prepare either a strong or a weak film, would be deemed to be within the scope of a skilled artisan.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

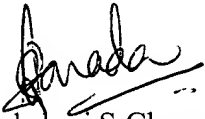
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the


Art Unit: 1615

organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala
Examiner
Art Unit 1615
December 30, 2002



THURMAN K. PAGE
SUPERVISOR/PATENT EXAMINER
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